

Remarks/Arguments:

Reconsideration of this application is respectfully requested. Upon entry of the amendments, claims 1-13 will be pending. Claims 1, 6, 7, and 13 have been amended herein to expressly disclaim the compound 1-butyl-3-methylimidazolium dibutylphosphate (equivalent to N-methyl-N-butylimidazolium dibutylphosphate), in view of the structure disclosed in Figure 1 of Sarbu et al., *Macromol. Chem. Phys.* 2001, 202, 3379-3391. This reference was brought to Applicants' attention in an Opposition Proceeding of a European patent corresponding to the instant application. Applicants were previously unaware of the reference and the overlap between the structure disclosed by Sarbu et al. and Applicants' claims was inadvertent. Although Applicants submitted Sarbu et al. as part of an IDS filed June 18, 2008 (No. 23), regrettably the reference was incomplete. Accordingly, Applicants resubmit the entire document herewith as part of a Supplemental IDS for the Examiner's consideration.

Claims 2, 5, 9, and 13 have been amended to correct typographical errors. No new matter has been added.

Applicants address the Examiner's rejections below.

Indefiniteness

Claims 1-6 are rejected under 35 USC § 112, ¶ 2 as incomplete for omitting essential steps. Applicants have amended claim 1 to insert R¹⁰. Reconsideration and withdrawal of the rejection is requested.

Novelty

Claims 1-13 are rejected under 35 USC § 102(a) as anticipated by Wasserscheid et al. (CAS No. 136:200188) ("Wasserscheid 1"); Holbrey et al. (CAS No. 138:338049) ("Holbrey"); and Wasserscheid et al. (CAS No. 140:78757) ("Wasserscheid 2"). Applicants traverse.

As acknowledged and pointed out by the Examiner, these references teach imidazolium sulfate compositions. *See* Office Action at page 3. However, proviso (iii) of claims 1 and 7 as

filed expressly disclaim such compounds. Therefore, the claims do not read on the cited references.

Applicants respectfully request reconsideration and withdrawal of the rejection.

Double Patenting

The Examiner rejected claims 1-13 on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1 or 30 of U.S. co-pending Application No. 10/549,223 to Zhou et al. ("Zhou"). According to the Examiner, although the conflicting claims are not identical, they are not patentably distinct from each other. Applicants respectfully traverse as the rejection is applied to the claims as amended herein.

First, Applicants rebut the rejection. The claimed invention of the instant application is directed, in relevant part, to phosphonium salt compounds, and process for preparing same, by reacting a tertiary phosphine (*i.e.*, wherein all of the radicals attached to the phosphorous atom are hydrocarbyl groups) with an ester of a sulfate/phosphate/phosphonate. On the other hand, Zhou claims methods for making a phosphonium salt using as a starting material a primary or secondary phosphine (*i.e.*, wherein one or two of the radicals attached to the phosphorous atom are hydrocarbyl and the other(s) is (are) hydrogen), rather than a tertiary phosphine. Since the nucleophilicity of primary and secondary phosphines is lower than that of tertiary phosphines, one of skill in the art would not have expected success in achieving a quaternary phosphonium salt using only a primary or secondary phosphine given the milder reaction conditions. Accordingly, Zhou is patentably distinct from the instant, earlier filed application.

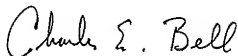
Second, even if Applicants' rebuttal to the obvious-type double patenting rejection is not held persuasive in this case, in view of Applicants' amendments and remarks made herein to the indefiniteness and novelty rejections, the double patenting rejection should be withdrawn. MPEP § 804(I)(B)(1) makes clear that as between co-pending applications, where an obvious-type double patenting rejection is the only rejection remaining in an earlier filed application (here, the instant application), the examiner should withdraw that rejection and permit the earlier filed application to issue as a patent without requiring a terminal disclaimer, so long as the later-filed application (in this case Zhou) is rejectable on other grounds. Currently, Zhou is rejected

on grounds of 35 USC § 103(a). Accordingly, the Examiner should withdraw the obvious-type double patenting rejection in the instant application as the purpose for which an obvious-type double patenting rejection is made (*i.e.*, to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent), will not be served.

On the basis of the foregoing amendments and remarks, action on the merits of the claims and a Notice of Allowance thereof are respectfully requested. Should any questions or issues arise concerning this application, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

With a 3 month petition for extension of time and payment of the corresponding fee, this response is due on or before April 9, 2009. The Commissioner is hereby authorized to charge any additional fees that may be due, or credit any overpayment of same, to Deposit Account No. 03-4083.

Respectfully submitted,



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